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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO.  | CONFIRMATION NO. |
|---|-------------|----------------------|----------------------|------------------|
| 09/713,770  | 11/16/2000  | Adam Coyle           |                      | 3444             |
| 20350   | 7590        | 05/01/2006           |                      | EXAMINER         |
| TOWNSEND AND TOWNSEND AND CREW, LLP<br>TWO EMBARCADERO CENTER<br>EIGHTH FLOOR<br>SAN FRANCISCO, CA 94111-3834 |             |                      | CAMPEN, KELLY SCAGGS |                  |
|   |             |                      | ART UNIT             | PAPER NUMBER     |
|   |             |                      | 3624                 |                  |
| DATE MAILED: 05/01/2006   |             |                      |                      |                  |

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                                 |                         |  |
|------------------------------|---------------------------------|-------------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b>          | <b>Applicant(s)</b>     |  |
|                              | 09/713,770                      | COYLE, ADAM             |  |
|                              | <b>Examiner</b><br>Kelly Campen | <b>Art Unit</b><br>3624 |  |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### **Status**

1) Responsive to communication(s) filed on \_\_\_\_\_.  
 2a) This action is **FINAL**.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### **Disposition of Claims**

4) Claim(s) 22 and 24-38 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_ is/are allowed.  
 6) Claim(s) 22, 24-38 is/are rejected.  
 7) Claim(s) \_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

#### **Application Papers**

9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on \_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### **Priority under 35 U.S.C. § 119**

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
     1. Certified copies of the priority documents have been received.  
     2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
     3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### **Attachment(s)**

|  |  |
|--|--|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____.<br>5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____.<br>6) <input type="checkbox"/> Other: _____. |  |

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 37-38 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 37 appears to be directed to a method for issuing prepaid negotiable instruments to an account holder but the body of the claim is directed to a transaction terminal for issuing negotiable instruments. The metes and bounds of the claim are unclear. In addition, there is not a **positively recited method step** of issuing prepaid negotiable instruments to an account holder. Lines 10-17 appear to be directed towards providing a server system where a negotiable (not prepaid) instrument is issued.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

- (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject

matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 22, 24-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gatto (US 6149055).

Gatto discloses a system for issuing prepaid negotiable instruments to an account holder comprising a database for storing an account identifier, a transaction terminal for issuing negotiable instruments and a server system in communication with the database and the transaction terminal (see abstract, col. 6-8) but does not disclose a means for issuing negotiable instruments. Gatto teaches an electronic fund transfer system where it may conduct a variety of transactions, including issuing negotiable instruments. It would have been obvious to one of

ordinary skill in the art at the time the invention was made to use the electronic funds transfer system of Gatto and use a means for issuing the negotiable instruments as Gatto teaches the system of electronic funds may be used to issue negotiable instruments (col. 5, lines 40-45). Examiner takes official notice that it was notoriously well known to use the further limitations of the dependent claims 24-36 as these limitations further enhance the usability of the system. It would have been obvious to one of ordinary skill in the art at the time the invention was made for the above reasons.

Specifically as to claims 37-38, see above rejection for claim 22 and in addition see abstract, see col. 2-5, see figs. 1, 5-6.

*Response to Arguments*

Applicant's arguments, see pages 6-7, filed 2/15/06, with respect to the 35 USC 101 technological arts rejection have been fully considered and are persuasive. The 35 USC 101 rejection of claims 37-38 has been withdrawn.

Applicant's arguments filed 2/15/2006 have been fully considered but they are not persuasive.

Since the applicant did not timely traverse the examiner's assertion of official notice, the well-known in the art statement, "that it was notoriously well known to use the further limitations of the dependent claims 23-36 as these limitations further enhance the usability of the system" is taken to be admitted prior art because applicant failed to traverse the examiner's assertion of official notice.

With respect to the 35 USC 112 second paragraph rejection, the claims do not include a positively recited step of issuing a prepaid negotiable instrument.

With respect to applicant's arguments that the ATM system in Gatto discloses no means for issuing negotiable instrument. Examiner points out that the ATM in the Gatto reference is capable of performing the function of issuing negotiable instruments.

***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kelly Campen whose telephone number is (571) 272-6740. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on (571) 272-6747. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

KSC

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